REMARKS

Claims 1-3, 5-7 and 9-19 are pending in the application.

Claims 1-3, 5-7 and 9-19 are rejected.

In the office action dated April 6, 2004, the following rejections are made. Claims 1 and 9-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wang U.S. Patent No. 6,580,420 in view of Toda U.S. Patent No. 6,496,179. Claims 2-3, 5-7 and 12-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Hiegel U.S. Patent No. 6,040,539. Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Toda and Marchant U.S. Patent No. 6,240,183. Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Hiegel and Smith. Claims 15 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Lee U.S. Patent No. 6,392,632. Claims 16 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Toda and Marchant. Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Toda and Karidis. These rejections are respectfully traversed.

Claims 1 and 9-11

Claim 1 recites a computer mouse comprising a motion sensor; and a collapsible housing for the motion sensor. The mouse is sized to fit within a PCMCIA slot when the housing is fully collapsed.

Wang discloses a pointing device that can function as either a mouse or a trackball (col. 6, lines 53-55). The pointing device includes an inner housing 102 slidably mounted to an outer housing 120. The inner housing 102 can be slid to a first position within the outer housing 120 (see Figure 6), and it can be slid to a second position adjacent to the outer housing 120 (see Figure 1). Wang does not teach or suggest a housing that can be collapsed to fit within a PCMCIA slot. To

the contrary, when the Wang's housing is collapsed, his pointing device is operable as a mouse (col. 8, lines 1-14).

The relevance of Toda is not clear. Toda discloses a position detector for a mouse that is light and thin (col. 2, lines 33-35). The position detector is a rotary encoder. Toda says nothing about the mouse being collapsible. See figure 11, for example, which shows the encoder 3 pivoting within the housing.

The office action states that Toda discloses a mouse sized to fit within a PCMCIA slot at col. 1, lines 17-23, col. 2, lines 1-6 and col. 2, lines 33-39. Applicant's attorney has reviewed these passages, but cannot find such disclosure. All these passages suggest is the desirability of a light, thin mouse. Toda's mouse is thin by virtue of a thin housing and a rotary encoder that can function within the thin housing. Thus, the combined teachings of Wang and Toda do not produce a mouse having all of the limitations recited in claim 1.

Moreover, the office cites no teaching, suggestion or reason for combining the teachings of Wang and Toda. According to MPEP 2143.01, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness, unless the prior art also suggests the desirability of the combination. Wang offers several reasons for collapsing his pointing device, including changing configurations between trackball and mouse, accommodating hands of different sizes, and operation with two hands instead of one (col. 2, lines 48-63). However, collapsing a mouse for storage is not one of those reasons. Toda does not suggest collapsing a mouse for storage either.

Thus prima facie obviousness of claim 1 has not been established. Therefore, claim 1 and its dependent claims 9-11 should be allowed over the combination of Wang and Toda.

Claims 5 , 2-3 and 12-13

Claim 5 recites a computer mouse comprising a motion sensor; and a collapsible housing for the motion sensor. The collapsible housing includes a rigid base and an upper portion attached to the base. The upper portion is made of an elastic material that allows the housing to be collapsed.

Wang 's pointing device can be collapsed by sliding the inner housing 102 into the outer housing 120. Wang does not teach or suggest a housing having a rigid base and an elastic upper portion attached to the base.

Hiegel discloses a protective cover for a computer mouse made of an elastic, flexible material. The cover stretches over the top and sides of the mouse, held firmly in place by the elastic action (see Abstract). The cover 10 has smaller dimensions than the mouse 90 that is intended to be covered (col. 2, lines 65-67). This is to allow the cover 10 to be stretched tautly across the mouse 90. The cover is designed to fit over Wang's outer housing 120, not replace it.

Thus, the combination of Wang and Hiegel does not produce a mouse having all of the limitations of claim 5. Therefore, claim 5 and its dependent clams 2-3 and 12-13 should be allowed over the combination of Wang and Hiegel.

Claims 6, 7 and 14

Claim 6 recites a computer mouse comprising a motion sensor; and a collapsible housing for the motion sensor. The collapsible housing includes a resilient plastic sheet having fold lines that allow the housing to collapse into a relatively flat structure.

Wang discloses a pointing device that can be collapsed by sliding an inner shell 102 into an outer shell 120. Heigel discloses a protective cover that is designed to stretch over and fit the contour of a mouse. The cover 10 has a cupped shaped for engaging the sides of the mouse 90 (col. 3, lines 1-3), and is preferably made of a material such as latex or silicone rubber (col. 2, line 64). Heigel's protective cover 90 does not have fold lines. Moreover, the combined

teachings of Wang and Hiegel do not produce a mouse that is collapsible into a relatively flat structure (Wang's outer housing 120 is not relatively flat).

Thus, the combination of Wang and Hiegel does not produce a mouse having all of the limitations of claim 6. Therefore, claim 6 and its dependent clams 2-3 and 12-13 should be allowed over the combination of Wang and Hiegel.

Claims 15 and 19

Claim 15 recites a computer mouse comprising a motion sensor including a sensor chip; and a collapsible housing for the motion sensor. The sensor chip is movable between a stowed position and a deployed position.

Lee discloses a light sensor. However, the office action offers no reason for replacing Wang's track ball with a sensor chip. Moreover, Wang does not disclose a stowed position for his pointing device.

Thus, the combination of Wang and Lee does not produce a mouse having all of the limitations of claim 15. Therefore, claim 15 and its dependent clam 19 should be allowed over the combination of Wang and Lee.

Claims 16 and 17-18

Claim 16 recites a combination comprising a mouse including a collapsible housing; and a PCMCIA card for communicating with the mouse. Neither Wang nor Toda teach or suggest a PCMCIA card for communicating with a mouse. Marchant does not either.

The office action states that Marchant discloses a PCMCIA card for communicating with a mouse at col. 5, 15-20 and 35-37. However, lines 15-20 merely states that Figure 3 shows multiple security units 52a-52f; and lines 35-37 simply state a security unit 52c is present upon a PCMCIA card, and the PCMCIA card is inserted into a slot.

Figure 3 of Marchant shows a mouse106 that is connected to a security unit 52a, not a PCMCIA card. The security unit 52a is connected to a mouse port. Figure 3 also shows mice 118 and 122 that are connected to security units

52d and 52e, not PCMCIA cards. The security units 52d and 52e are connected to keyboards 116 and 120.

Thus the combined teachings of Wang, Toda and Marchant do not produce the combination recited in claim 16. Accordingly, claim 16 and its dependent claims 17-18 should be allowed over Wang, Toda and Marchant.

'112 rejections of claims 11 and 16-18

Claims 11 and 16-18 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite because "PCMCIA" is not defined. However, the office action does not explain why the well-known term PCMCIA must be defined in the claims and, therefore, has not established prima facie indefiniteness. Since the term PCMCIA is well known, it should not have to be defined in the claims Therefore, the '112 rejections should be withdrawn.

Conclusion

The examiner is respectfully requested to withdraw the rejections and issue a notice of allowability. If issues remain, the examiner is invited to contact the undersigned to discuss those remaining issues.